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EXAMINER				
YU, HENRY W				
ART UNIT		PAPER NUMBER		
2182				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

vera.kublanov@philips.com

debbie.henn@philips.com

marianne.fox@philips.com

Office Action Summary**Application No.**

10/566,001

Applicant(s)

POSTMA ET AL.

Examiner

HENRY YU

Art Unit

2182

Period for Reply -- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-19 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-19 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 20 January 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-C1000)
- _____
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

INFORMATION CONCERNING RESPONSES

Response to Amendment

1. This Office Action is in response to applicant's communication filed on October 21, 2011, in response to PTO Office Action mailed on July 21, 2011. The Applicant's remarks and amendments to the claims and/or the specification were considered with the results that follow.
2. In response to the last Office Action, **claims 1 and 9** have been amended. As a result, **claims 1-19** are now pending in this application.

Response to Arguments

3. Applicant's arguments filed on October 21, 2011, in response to PTO Office Action mailed on July 21, 2011, have been fully considered and are persuasive. Hence, the rejection has been withdrawn. However, upon further review a new ground of rejection has been made in view of Hayes et al. (Patent Number US 7,218,243 B2).

REJECTIONS BASED ON PRIOR ART

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-13 and 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Striemer (Patent Number US 6,931,463 B2) in view of Hayes et al. (Patent Number US 7,218,243 B2), Hind et al. (Patent Number US 6,772,331 B1) and Hawkins et al. (Patent Number US 6,516,202 B1).

As per **claim 1**, Striemer discloses *"an [entertainment] system comprising one or more functionality devices (**companion device that provides non-native function to a different electronic device; Column 1, lines 54-56**) and an [entertainment] device for cooperating with the one or more functionality devices in the entertainment system, the entertainment device adapted so that the one or more functionality devices are locatable in proximity to the [entertainment] device (**Column 1, lines 59-65**)."*

Striemer also discloses *"the [entertainment] device being operable to recognize the presence of the one or more functionality devices (**Column 1, lines 59-62**), and, upon recognition of said one or more functionality devices (**where the electronic device links with the companion device; FIG. 5**)."*

Striemer discloses *"the entertainment device being operable to perform the one or more additional functionality features associated with said one or more functionality devices and which are non-standard features of said [entertainment] device (**Abstract, lines 1-2**), wherein the additional functionality features [are unrelated to and different from the standard features of the entertainment device, controllable via a remote control and] are performed whilst the one or more functionality devices is in proximity to the*

electronic device (see FIG. 4 as it relates to the device 410 and companion device 490)."

Hind et al. discloses the following limitation not explicitly disclosed by Striemer: *"the one or more functionality devices being externally activated, via [a remote control device, wherein the activation is conditional upon communication of one or more codes], to provide external regulation on use of one or more additional functionality features to be performed whilst the one or more functionality devices is in proximity to the entertainment device (where the user pushes a button when the devices are in radio proximity; Column 13, lines 13-43)."*

As for Hind et al., the idea of using buttons and switches not only allows for a manufacturer to uniquely pair two specific devices together [Column 13, lines 36-39], but also to preclude a device from having to always need to leave a transceiver on in order to prepare for potential pairing to another device. Such action of always leaving a transceiver on can lead to greater energy use, which is detriment to devices that use only portable forms of energy storage such as a battery.

Hayes et al. discloses the use of a remote control device that activates a function that is not explicitly disclosed by Striemer or Hind et al.: *"a remote control device, wherein the activation is conditional upon communication of one or more codes (Column 14, lines 28-33)."*

Hayes et al. discloses an entertainment device that is capable of obtaining additional features that is not explicitly disclosed by Striemer or Hind et al. [Column 14, lines 20-36].

Hayes et al. discloses that additional features can be controlled through a remote control **[Column 14, lines 20-36]**.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine elements of Striemer and Hind et al. with elements of Hayes et al. It is noted that both Striemer and Hayes et al. disclose systems which are capable of being updated by external means (functionality devices in the case of Striemer and a database server and remote control in the case of Hayes et al.). By including the use of a remote control in the configuration and activation of functions, one is able to more easily include the ability to automatically configure a remote control (which adds to user convenience as a user does not physically have to be at the same location as a device in order to change a particular setting such as a TV channel) as opposed to manually configuring the remote control **[Column 1, lines 28-45]**.

Hawkins et al. discloses the idea of including features with no relationship with standard features of a device that is not explicitly disclosed by Striemer, Hayes et al., and Hind et al.: *"are unrelated to and different from the standard features of the [entertainment] device (the example is a cellular phone module within the context of a standalone PDA without external wireless communication capability; Column 1, lines 44-51)."*

Hawkins et al. discloses *"wherein standard features of the [entertainment] device are configured to be (i) concurrently operable with the one or more additional functionality features such that the [entertainment] device automatically recognizes, accepts, and carries out the non-standard features of the one or more functionality*

devices based on the proximity of the one or more functionality devices to the [entertainment] device (FIG. 5A)."

As for Hawkins et al., the ability to accept additional functionalities on top of standard functions allows for greater flexibility and usefulness for a user.

As per **claim 2**, the combination Strierner, Hayes et al., Hind et al., and Hawkins et al. discloses "*the system*" (see rejection to **claim 1** above). Hawkins et al. discloses "*at least one of said one or more functionality devices is arranged to be attachable to the entertainment device by means of at least one of a magnetic coupling, a suction pad, an adhesive coupling and a mechanical attachment mechanism (expansion module is attached through a slot 320; FIG. 3A).*"

As per **claim 3**, the combination of Strierner, Hayes et al., Hind et al., and Hawkins et al. discloses "*the system*" (see rejection to **claim 1** above). Strierner further discloses "*at least one of said one or more functionality devices (companion device) and the...device (from the companion device's perspective, a different electronic device) are operable to communicate via wireless communication by using an electromagnetic signal (Column 1, lines 56-59).*"

As per **claim 4**, the combination of Strierner, Hayes et al., Hind et al., and Hawkins et al. discloses "*the system*" (see rejection to **claim 1** above). Strierner further discloses "*the electromagnetic signal is implemented using electromagnetic radiation complying with the Bluetooth standard (Column 1, lines 56-59).*"

As per **claim 5**, the combination of Strierner, Hayes et al., Hind et al., and Hawkins et al. discloses "*the system*" (see rejection to **claim 1** above). Strierner further

discloses "access to the one or more additional functionality features of said one or more functionality devices is conditional upon activation of the one or more functionality devices **(from the electronic device's perspective, in order to activate the functions of the companion device a link must established, along with the proper authentication and authorization information; Column 5, lines 1-17).**"

As per **claim 6**, the combination of Striemer, Hayes et al., Hind et al., and Hawkins et al. discloses "the system" (see rejection to **claim 1** above). Hawkins et al. discloses "said one or more functionality devices are activated in response to actuation of a switch or button on the device **(as it pertains to buttons 356 and 357; Column 3, lines 36-48).**"

As per **claim 7**, the combination of Striemer, Hayes et al., Hind et al., and Hawkins et al. discloses "the system" (see rejection to **claim 1** above). Striemer further discloses "at least one of said one or more functionality devices is activated by using electromagnetic signal communication with an additional device **(through the use of a local wireless interface in conjunction with identification mechanism; Column 5, lines 3-9).**"

As per **claim 8**, the combination of Striemer, Hayes et al., Hind et al., and Hawkins et al. discloses "the system" (see rejection to **claim 1** above). Striemer further discloses "the activation is conditional upon communication of one or more codes **(in order to establish a link, and hence from the electronic device's perspective activate the functionality of the companion device, authentication and authorization information are required; Column 5, lines 9-14).**"

As per **claim 9**, Striemer discloses *"a method of providing additional functionality to an...device, the method including the steps of: providing an [entertainment] device operable to performing a set of functions (Column 1, lines 59-65)" and "providing at least one functionality device adapted so as to be engagable in at least close spatial proximity to the [entertainment] device (Column 1, lines 59-65)."*

Striemer also discloses *"(c) arranging for said [entertainment] device to be capable of recognizing the presence of said at least one functionality device when in close spatial proximity to the [entertainment] device (Column 1, lines 59-65)" and "arranging for the [entertainment] device to be updated with and to perform one or more additional functionality features associated with said at least one functionality device and which are non-standard features of said [entertainment] device (Abstract, lines 1-2)" and "based on the proximity of the one or more functionality devices to the [entertainment] device (see FIG. 4 as it relates to the device 410 and companion device 490)."*

Hind et al. discloses the following limitation not explicitly disclosed by Striemer: *"externally activating the one or more functionality devices via a [remote control device, wherein the activation is conditional upon communication of one or more codes], to provide external regulation on use of one or more additional functionality features to be performed whilst the one or more functionality devices is in proximity to the entertainment device (where the user pushes a button when the devices are in radio proximity; Column 13, lines 13-43)."*

As for Hind et al., the idea of using buttons and switches not only allows for a manufacturer to uniquely pair two specific devices together [**Column 13, lines 36-39**], but also to preclude a device from having to always need to leave a transceiver on in order to prepare for potential pairing to another device. Such action of always leaving a transceiver on can lead to greater energy use, which is detriment to devices that use only portable forms of energy storage such as a battery.

Hayes et al. discloses the use of a remote control device that activates a function that is not explicitly disclosed by Striemer or Hind et al.: *"remote control device, wherein the activation is conditional upon communication of one or more codes (Column 14, lines 28-33)."*

Hayes et al. discloses an entertainment device that is capable of obtaining additional features that is not explicitly disclosed by Striemer or Hind et al. [**Column 14, lines 20-36**].

Hayes et al. discloses that additional features can be controlled through a remote control [**Column 14, lines 20-36**].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine elements of Striemer and Hind et al. with elements of Hayes et al. It is noted that both Striemer and Hayes et al. disclose systems which are capable of being updated by external means (functionality devices in the case of Striemer and a database server and remote control in the case of Hayes et al.). By including the use of a remote control in the configuration and activation of functions, one is able to more easily include the ability to automatically configure a remote control (which adds to user

convenience as a user does not physically have to be at the same location as a device in order to change a particular setting such as a TV channel) as opposed to manually configuring the remote control [Column 1, lines 28-45].

Hawkins et al. discloses the following limitations not explicitly disclosed by Striemer, Hayes et al., and Hind et al.: *"wherein standard features of the [entertainment] device are configured to be (i) concurrently operable with the one or more additional functionality features such that the [entertainment] device automatically recognizes, accepts, and carries out the non-standard features of the one or more functionality devices (FIG. 5A)."*

Hawkins et al. discloses *"wherein the additional functionality features are unrelated to and different from the standard features of the entertainment device [and controllable via a remote control] (the example is a cellular phone module within the context of a standalone PDA without external wireless communication capability; Column 1, lines 44-51)."*

As for Hawkins et al., the ability to accept additional functionalities on top of standard functions allows for greater flexibility and usefulness for a user.

As per claim 10, the combination of Striemer, Hayes et al., Hind et al., and Hawkins et al. discloses *"the method"* (see rejection to claim 9 above). Hawkins et al. discloses *"close spatial proximity corresponds to physical contact between said entertainment device and said at least one functionality device (expansion module is attached through a slot 320; FIG. 3A)."*

As per **claim 11**, the combination of Strierner, Hayes et al., Hind et al., and Hawkins et al. discloses "*the method*" (see rejection to **claim 9** above). Hawkins et al. discloses "*said at least one functionality device is attached to the entertainment device by means of at least one of a magnetic coupling, a suction pad, an adhesive coupling and a mechanical attachment mechanism (expansion module is attached through a slot 320; FIG. 3A).*"

As per **claim 12**, the combination of Strierner, Hayes et al., Hind et al., and Hawkins et al. discloses "*the method*" (see rejection to **claim 9** above). Strierner further discloses "*said at least one functionality device (companion device) and said...device (from the companion device's perspective, a different electronic device) are arranged to mutually communicate via wireless communication utilizing an electromagnetic signal (Column 1, lines 56-59).*"

As per **claim 13**, the combination of Strierner, Hayes et al., Hind et al., and Hawkins et al. discloses "*the method*" (see rejection to **claim 9** above). Strierner further discloses "*the electromagnetic signal complies with the Bluetooth standard (Column 1, lines 56-59).*"

As per **claim 18**, the combination of Strierner, Hayes et al., Hind et al., and Hawkins et al. discloses "*the system*" (see rejection to **claim 1** above). Hayes et al. further discloses "*said entertainment device is selected from the group consisting of a DVD player and a television (Column 1, lines 28-32).*"

As per **claim 19**, the combination of Strierner, Hayes et al., Hind et al., and Hawkins et al. discloses "*the method*" (see rejection to **claim 9** above). Hayes et al. further discloses "*said entertainment device is selected from the group consisting of a DVD player and a television (Column 1, lines 28-32).*"

6. **Claims 14 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Strierner (Patent Number US 6,931,463 B2), Hayes et al. (Patent Number US 7,218,243 B2), Hind et al. (Patent Number US 6,772,331 B1), and Hawkins et al. (Patent Number US 6,516,202 B1) in view of Silvester (Publication Number US 2003/0068034 A1).

As per **claim 14**, while the combination of Strierner, Hayes et al., Hind et al., and Hawkins et al. discloses "*the system*" (see rejection to **claim 5** above), Silvester discloses the idea of latent functionality features being present in an entertainment device that are augmented by upgrade modules as "*wherein the one or more additional functionality features are latently present in said entertainment device and access to said additional functionality is available while one or more functionality devices are attached (modules may provide added functionality such as additional memory, additional processing, and the like (Abstract; Lines 3-6). The use of the term "added" indicates augmentation of current functions in the device, such as memory and processing in this instance).*"

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the method as disclosed by the combination of Strierner, Hayes et al., Hind et al., and Hawkins et al. with elements of Silvester, which notes that when a

user decides to upgrade to a more advanced device, the existing device becomes largely useless. This is compounded by the fact that the resale value of basic devices is relatively limited **[Page 1, paragraph 0002]**. Hence, in order to prolong the lifespan of the basic device and have the basic device remain useful to the user in the face of increasing technological advancement, the use of modules that augments the basic device can be of great use.

As per **claim 17**, while the combination of Strierner, Hayes et al., Hind et al., and Hawkins et al. discloses "*the system*" (see rejection to **claim 5** above), Silvester discloses "*wherein the one or more additional functionality features are made available to said entertainment device from an external storage medium after attachment of the one or more functionality devices (the card 66 contains a storage 58 that includes software; Page 1, paragraph 0016; FIG. 3).*"

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the method as disclosed by the combination of Strierner, Hayes et al., Hind et al., and Hawkins et al. with elements of Silvester, which notes that when a user decides to upgrade to a more advanced device, the existing device becomes largely useless. This is compounded by the fact that the resale value of basic devices is relatively limited **[Page 1, paragraph 0002]**. Hence, in order to prolong the lifespan of the basic device and have the basic device remain useful to the user in the face of increasing technological advancement, the use of modules that augments the basic device can be of great use.

7. **Claims 15-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Striemer (Patent Number US 6,931,463 B2), Hayes et al. (Patent Number US 7,218,243 B2), Hind et al. (Patent Number US 6,772,331 B1), and Hawkins et al. (Patent Number US 6,516,202 B1) in view of Kelley et al. (Publication Number US 2004/0253944 A1).

As per **claim 15**, while the combination of Striemer, Hayes et al., Hind et al., and Hawkins et al. discloses *"the system"* (see rejection to **claim 1** above), Kelley et al. discloses *"wherein a set of user preferences for an entertainment device is included on said one or more functionality devices (the RF-ID device is programmed to store the user preferences; Page 4, paragraph 0047)."*

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the method as disclosed by the combination of Striemer, Hayes et al., Hind et al., and Hawkins et al. with elements of Kelley et al., which notes that it is desirable to provide a way for users to upgrade the capability of their devices (in this case phones) without having to purchase an entirely new replacement phone [Page 1, paragraph 0005]. Furthermore, by including user preferences the user can utilize any similar device without being tied to one particular device [Page 4, paragraph 0047].

As per **claim 16**, the combination of Striemer, Hayes et al., Hind et al., Hawkins et al., and Kelley et al. discloses *"the system"* (see rejection to **claim 1** above). Kelley et al. further discloses *"wherein said set of user preferences is transferable to a new entertainment device after relocating said one or more functionality devices to said new entertainment device (Pages 4-5, paragraph 0047)."*

RELEVANT ART CITED BY THE EXAMINER

8. The following prior art made of record and relied upon is cited to establish the level of skill in the applicant's art and those arts considered reasonably pertinent to applicant's disclosure. See **MPEP 707.05(c)**.

U.S. PATENT NUMBERS:

2003/0048295 A1

CLOSING COMMENTS

Conclusions

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY YU whose telephone number is (571)272-9779. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TARIQ HAFIZ can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. Y./
Examiner, Art Unit 2182
December 8, 2011

/Tariq Hafiz/
Supervisory Patent Examiner, Art Unit 2182